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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/628,023	07/28/2000	Shigeo Yamagata	35.C14654	2202
5514	7590	08/22/2005	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO			PHAM, THIERRY L	
30 ROCKEFELLER PLAZA			ART UNIT	
NEW YORK, NY 10112			PAPER NUMBER	

2624

DATE MAILED: 08/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/628,023

Applicant(s)

YAMAGATA ET AL

Examiner

Thierry L. Pham

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 9-14, 17-20, 24-27, 31, 32, 40-42 and 46 is/are pending in the application.
- 4a) Of the above claim(s) 18-20, 24-27, 31-32, 40-42 and 46 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 9-14 and 17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>7/8/05</u>  | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

- This action is responsive to the following communication: an Amendment filed on 6/24/05.
- Claims 9-14, 17-20, 24-27, 31-32, 40-42, and 46 are pending. Claims 1-8, 15-16, 21-23, 28-30, 33-39, 43-45, and 47-63 have been canceled.
- IDS filed on 7/8/05 has been considered and entered.

### ***Election/Restrictions***

This application contains claims directed to the following patentably distinct species of the claimed invention:

Group I, claims 9-14, and 17, drawn to an image processing apparatus for determining whether the received image data is generated from image generating apparatus having forgery function or not, classified in class 358/1.14, as shown in fig. 5 of 3<sup>rd</sup> Embodiment.

Group II, claims 18-20, 24-27, and 31-32, drawn to an image processing apparatus for comparing different types of specific image pattern, classified in class 382, subclass 182, as described in Fourth Embodiment.

Group III, claims 40-42, and 46, drawn to an image processing method for performing judgment whether the inputted image has been performed for pattern detection or not, classified in 358, subclass 328, as described in Seventh Embodiment.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claims are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after

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the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

During a telephone conversation with Brian Klock on 08/08/05 a provisional election was made without traverse to prosecute the invention of Group I, claims 9-14, and 17. Affirmation of this election must be made by applicant in replying to this Office action. Claims 18-20, 24-27, 31-32, 40-42, and 46 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 9-14 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Nakai et al (U.S. 5909602).

Regarding claim 9, Nakai discloses an image processing apparatus (copy machine 93, fig. 11), comprising:

- receiving means (receiving image data from plurality of different sources via I/F interface, i.e., ref. 91-92, ref. 94, fig. 11) for receiving color image data from any of an image generating apparatus having a forgery judging function and an image generating apparatus not having a forgery judging function;
- judging means (copy machine 93 also includes PCU 74 of fig. 4 for judging confidential contents of received image data, i.e., paper money, col. 31, lines 28-67) for judging whether a

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color image composed of the color image data received by said receiving means is a specific image; and

- output means (copy machine 93 also includes image data output portion 72 (fig. 4) for outputting image data receiving from plurality of external sources, fig. 11) for outputting the color image data so as to make an image forming unit form a color image by using the color image data received from said receiving means, wherein the image processing apparatus controls formation of the color image according to a result of judgment in the image generating apparatus having the forgery judging function (received image data that has a confidential marks will print with lower resolution and/or not printing at all, cols. 31-35, for example, image data from copy machine 92) if the color image data is generated by the image generating apparatus having the forgery judging function (copy machine 93 receives image data from plurality of external devices, i.e. copy machine 92-91 which also includes a judgment means PCU 74 or scanner 94, fig. 11, cols. 31-35), and controls formation of the color image according to a result of judgment by said judging means if the color image data is generated by the image generating apparatus not having the forgery judging function (image data received from scanner 94 (which does not include any forgery judging function) will be printed normally and/or if the received image data contains no confidential contents, then the normal printing is carried out, cols. 31-35, for example, image data from copy machine 91).

Regarding claim 10, Nakai further discloses the image processing apparatus according to claim 9, wherein the image generating apparatus is a scanner (scanner 94, fig. 11) or a digital camera.

Regarding claim 11, Nakai further discloses the image processing apparatus according to claim 9, wherein the specific image is a security such as bank note, and a traveler's check (securities, col. 31, lines 10-17).

Regarding claim 12, Nakai further discloses the image processing apparatus according to claim 9, wherein said judging means judges the color image data by pattern matching (col. 31,

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lines 35-36) or color matching, or judges digital water mark information included in the color image.

Regarding claim 13, Nakai further discloses the image processing apparatus according to claim 9, wherein the image generating apparatus having a forgery judging function transmits a result of the forgery judgment ahead of the color image data (copy machine 92 includes a lower judging means for judging the image data prior sending to copy machine 93 for higher judging means, fig. 40, cols. 33-34).

Regarding claim 14, Nakai further discloses the image processing apparatus according to claim 9, wherein said receiving means receives the color image data via a network (network, fig. 11).

Regarding claim 17, Nakai further discloses an image processing method, comprising the steps:

- receiving (receiving image data from plurality of different sources via I/F interface, i.e., ref. 91-92, ref. 94, fig. 11) color image data from any of an image generating apparatus having a forgery judging function and an image generating apparatus not having a forgery judging function;
- judging (copy machine 93 also includes PCU 74 of fig. 4 for judging confidential contents of received image data, i.e., paper money, col. 31, lines 28-67) whether a color image composed of the color image data received by said received step is a specific image; and
- outputting (copy machine 93 also includes image data output portion 72 (fig. 4) for outputting image data receiving from plurality of external sources, fig. 11) the color image data so as to make an image forming unit form a color image by using the color image data received, wherein the image processing method further comprises the steps of controlling formation of the color image according to a result of judgment in the image generating apparatus having the forgery judging function (received image data that has a confidential marks will print with lower resolution and/or not printing at all, cols. 31-35) if the color image data is generated by the image generating apparatus having the forgery judging function (copy machine 93 receives image data

from plurality of external devices, i.e. copy machine 92-91 which also includes a judgment means PCU 74 or scanner 94, fig. 11, cols. 31-35), and controlling formation of the color image according to a result of judgment by said judging step if the color image data is generated by the image generating apparatus not having the forgery judging function (image data received from scanner 94 will be printed normally and/or if the received image data contains no confidential contents, then the normal printing is carried out, cols. 31-35).

### *Response to Arguments*

Applicant's arguments filed 6/24/05 have been fully considered but they are not persuasive.

- Regarding claim 9, the applicants argued the cited prior art of record (US 5909602 to Nakai et al) fails to teach and/or suggest “the copy machine 93 returns the result of judging to the copy machine 91, but does not receive a judged result from the copy machine 91. Therefore, the copy machine 93 does not control formation of a color image according to a result of judgment in an image generating apparatus having a forgery judging function because copy machine 93 does not even receive a judged result from copy machine 91. Further, copy machine 93 does not control formation of a color image according to a result of the judgment by its judging means, because copy machine 93 does not perform color image forming based on the judgment result of the judging unit”.

In response, the examiner disagrees with applicants' arguments. First, the examiner notes that limitations/features as cited in claim 1 do not indicate and/or specify what type of “control formation” is performed based upon a result of a judgment. Herein, the examiner interprets “control formation” as the received image data that has a confidential mark will print with lower resolution and/or not printing at all, and if the received image data that has no confidential mark, normal operation is carried out, cols. 31-35. Secondly, Nakai implicitly teaches a copy machine 93 for receiving image data from copy machine 91 and/or 92, as shown in fig. 11, col. 36, lines 53-60. Copy machine 92 includes a forgery function for judging whether the inputted image contains any confidential marks/patterns. If further judgment is required, the inputted image from copy machine 92 is transmitted to copy machine 93 for further judging (col. 34, lines 1-15). Copy machine 91 do not have any forgery function for judging whether the inputted image

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contain any confidential marks/patterns. Inputted image from copy machine 91 is to be judged by copy machine 93 for any confidential marks/patterns (col. 32, lines 10-62 and col. 33, lines 40-61, col. 35, lines 30-42). Notes: PCU 74 judges that the input image as being the copy-prohibited image, the PCU 74 indicates that the copying of the subject document is prohibited on the liquid crystal display or alters the outputted image with lower resolution, cols. 31-32.

- Independent claims 18, 25, 40 have been amended to include new limitations/features; as a result, election of species is raised, and therefore, claims 18, 25, and 40 have been withdrawn from consideration. Please refer to election of species for more details.

### *Conclusion*

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thierry L. Pham whose telephone number is (571) 272-7439. The examiner can normally be reached on M-F (9:30 AM - 6:00 PM).

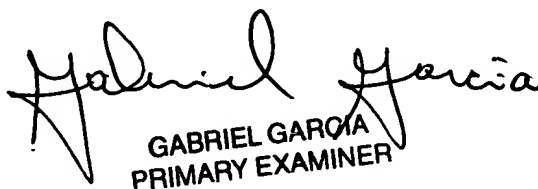
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on (571)272-7437. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Thierry L. Pham



GABRIEL GARCIA  
PRIMARY EXAMINER